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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/328,626	06/09/1999	STEVEN A. BOVE	245-111	7062

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PHILADELPHIA, PA 19103

EXAMINER

FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 06/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/328,626

Applicant(s)
Bove et al

Examiner
Daniel Felten

Art Unit
3624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 5, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-11, 13-21, 23-25, 27-50, 52-54, and 56-62 is/are rejected.
- 7) ☒ Claim(s) 8, 12, 22, 26, 51, and 55 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

- 1
- 2 1. Receipt of the amendment filed March 5, 2002 adding claims 59-62 is acknowledged.
- 3 Claims 1-62 are pending in the application and are presented to be examined upon their merits.
- 4
- 5

Response to Arguments

- 6
- 7 2. Applicant's arguments with respect to claims 1-7, 9-11, 13-21, 23-25, 27-29, 8, 12,
- 8 22, 26, 51 and 55 have been considered but are moot in view of the new ground(s) of
- 9 rejection.
- 10

Claim Rejections - 35 USC § 103

- 11
- 12 3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
- 13 obviousness rejections set forth in this Office action:

14 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in

15 section 102 of this title, if the differences between the subject matter sought to be patented and the prior art

16 are such that the subject matter as a whole would have been obvious at the time the invention was made to a

17 person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be

18 negated by the manner in which the invention was made.

19

1 4. Claims 1-7, 9-11, 13-21, 23-25 and 27-29 are rejected under 35 U.S.C. 103(a) as being
2 unpatentable over Edesess (US 5,884, 287) in view of Alden (US 5,418,888).

3 **Regarding claims 1 and 15:**

4 Edesess discloses a computerized process and product for automating and executing
5 investment planning for a client comprising:

6 (a) inputting into a computer data regarding the client's desired asset portfolio(see
7 Edesess, col. 4, ll. 27-30; col. 39, ll. 47-50; col. 5, ll. 15-19) , as in

8 (b)...desired allocation (see Edesess, col. 4, ll. 45-55; col. 5, ll. 15-22),

9 (c)... preferred domain (see Edesess, col. 5, ll. 38)

10 (d)...to automatically generate financial transaction recommendations for modifying the
11 clients current asset portfolio to reach as close as possible to the desired asset allocation and
12 preferred domain (see Edesess, fig. 6, "*Contributions should be increased and/or expenditures*
13 *reduced when in this zone.*")

14 (e) displaying the recommendations on a summary report for review by the client or
15 the client's financial manager (see Edesess, figs. 4-6; col. 6, ll. 33+)

16 Edesess fails to disclose recommendations for selling amounts of selected current assets
17 and specific recommendations for buying amounts of one or more investment funds.

18 Alden discloses an expert system embodiment which includes an application that
19 recommends buy or selling of assets, particularly stocks (see Alden, col. 36, ll. 34+). It would
20 have been obvious for an artisan of ordinary skill at the time of the invention of Edesess to

1 integrate the aforementioned feature of Alden into the Edesess invention because an artisan at
2 the time of the invention would have recognized that the notoriously old and well known
3 method of buying and/or selling stocks/commodities to improve portfolio performance would
4 provide the Edesess system with an alternative of optimizing the investment plan to reach the
5 target scenario. Thus such a modification would have been an obvious expedient to one of
6 ordinary skill in the art.

7
8 **Regarding claims 2 and 16:**

9 Edesess in view of Alden discloses wherein step(d) includes determining tax impacts of
10 potential sell transactions, the recommendations being selected to minimize the tax impacts (see
11 Edesess, col. 5, ll. 38+).

12
13 **Regarding claims 3 and 17:**

14 Edesess in view of Alden discloses wherein the summary report includes tax impacts of
15 at least some of the recommendations (see Edesess, fig. 4 col. 6, ll. 33+).

16
17 **Regarding claims 4 and 18:**

18 Edesess in view of Alden discloses, (f) inputting into a computer data regarding the
19 clients asset portfolio preferences, including current assets that the client wishes to hold or sell,
20 and constraints on asset selling, wherein, step

1 (d) further includes using the data in step (f) to automatically generate the financial
2 transaction recommendations (see Alden, col. 36, ll. 34+).

3
4 **Regarding claims 5 and 19:**

5 Edesess in view of Alden discloses wherein step (d) includes determining transaction
6 costs of potential sell transactions, the recommendations being selected to minimize the
7 transaction costs (see Alden, "Totalcost", col. 42, 23+).

8
9 **Regarding claims 6 and 20:**

10 Edesess in view of Alden discloses wherein the summary report includes the transaction
11 costs of at least some of the recommendations (see Alden, "Totalcost", col. 42, 23+).

12
13 **Regarding claims 7 and 21:**

14 Edesess in view of Alden discloses wherein the client's current asset portfolio includes
15 repositionable assets, non-repositionable assets and possibly repositionable assets, and step (d)
16 includes a recommendation to hold the client's possibly repositionable assets if the client's new
17 asset location will be within a predetermined percentage of the desired asset allocation after
18 selling all the client's repositionable assets (see Alden, col. 36, ll. 34+).

Regarding claims 9 and 23:

Edesess in view of Alden discloses wherein the client's current asset portfolio includes repositionable assets, non-repositionable assets and possibly repositionable assets, and step

(d) includes treating the possibly repositionable assets as non-repositionable assets when making the current asset portfolio modifications (see Alden, col. 36, ll. 34+).

Regarding claims 10 and 24:

Edesess in view of Alden discloses wherein the client's current asset portfolio includes repositionable assets, non-repositionable assets and possibly repositionable assets, and step

(d) includes a recommendation to sell the client's repositionable asset until the tax cost of selling equals a predetermined percentable of the client's current asset portfolio (see Alden, col. 36, ll. 34+).

Regarding claims 11 and 25:

Edesess in view of Alden discloses wherein recommendations include recommendations to (I) add specific amounts of shares to currently held mutual funds, and (ii) open one or more new mutual funds and contribute specific amounts of shares to the new funds (see Alden, col. 36, ll. 34+).

1
2
3 **Regarding claims 13 and 27:**

4 Edesess in view of Alden discloses wherein step (d) includes developing target
5 portfolio amounts and adjusted target portfolio amounts for each asset category in the desired
6 asset allocations (see Edesess, fig. 4, col. 6, ll. 33+).

7
8 **Regarding claims 14 and 28:**

9 Edesess in view of Alden discloses (f) inputting information regarding the client which
10 is necessary to determine the client's desired asset allocation and the client's preferred domain;
11 and

12 (g) automatically determining the client's desired asset allocation and the client's
13 preferred domain and using the results as the data inputs in steps (b) and (c) (see Edesess, col.
14 5, ll. 15+).

15
16 **Regarding claims 29:**

17 Edesess in view of Alden discloses wherein step (e) further comprises communication
18 the specific recommendations for selling amounts of selected current assets and specific
19 recommendations for buying amounts of one or more investment funds to a trade execution

1 computer which automatically performs the necessary transactions to execute the buy/sell
2 recommendations (see Alden, col. 36, ll. 34+).

3
4
5 5. Claims 30-36, 38-40, 42-50, 51-54 and 56-62 are rejected under 35 U.S.C. 103(a) as
6 being unpatentable over Edesess (US 5,884,287) as modified by Alden (US 5,418,888) as
7 applied to claim 1 above, and further in view of Robinson et al (hereinafter referred to as
8 "Robinson", US 5388,248). The teachings of Edesess as modified by Alden have been
9 discussed above.

10
11 **Regarding claims 30 and 44:**

12 Edesses as modified by Alden fails to disclose computer program product including at
13 least one computer readable medium. Computer readable medium (i.e., IC cards, floppy disks,
14 or compact discs, software packages, etc..) are commonly used in the art to download various
15 computer programs onto computer hard drives for either individual "stand alone" usage, or in
16 conjunction with a network such as the Internet (i.e., American On-line software). Robinson
17 teaches a computer readable medium that has a user programmable memory storage (see
18 Robinson col. 4, ll. 40+). In view of Robinson flash memory card, it would have been
19 obvious for an artisan of ordinary skill at the time of the invention of Edesess as modified by
20 Alden to employ the computer readable medium of Robinson to store the program and to be

1 later downloaded onto a computer system. The computer medium would have provided a
2 convenient means to physically transport software from computer to computer. Thus to provide
3 a computer medium with the aforementioned program would have been an obvious expedient
4 well within the ordinary skill in the art.

5
6 **Regarding claims 31 and 45:**

7 (see explanation for claims 2 and 16)
8

9 **Regarding claims 32 and 46:**

10 see explanation for claims 3 and 17)
11

12 **Regarding claims 33 and 47:**

13 see explanation for claims 4 and 18)

14 **Regarding claims 34 and 48:**

15 see explanation for claims 5 and 19)
16

17 **Regarding claims 35 and 49:**

18 see explanation for claims 6 and 20)
19
20

Regarding claims 36 and 50:

see explanation for claims 7 and 21)

Regarding claims 38 and 52:

see explanation for claims 9 and 23)

Regarding claims 39 and 53:

see explanation for claims 10 and 24)

Regarding claims 40 and 54:

(see explanation for claims 11 and 25)

Regarding claims 42 and 56:

(see explanation for claims 13 and 27)

Regarding claims 43 and 57:

(see explanation for claims 14 and 28)

Regarding claims 58:

(see explanation for claims 29)

1 **Regarding claims 59-62:**

2 (see Alden, col. 36, ll. 34+)

3
4
5 *Allowable Subject Matter*

6
7 6. Claims 8, 12, 22, 26, 51 and 55 are objected to as being dependent upon a rejected base
8 claim, but would be allowable if rewritten in independent form including all of the limitations
9 of the base claim and any intervening claims.

10 7. The following is a statement of reasons for the indication of allowable subject matter:

11
12 **Regarding claims 12, 26, 37 and 51:**

13 the applicant discloses wherein the desired asset allocation is determined based upon the
14 client's Ibbotson score which is not disclosed within the prior art.

15
16 **Regarding claims 8, 22, 41 and 55:**

17 the applicant discloses wherein the predetermined percentage is about 3% which is not
18 disclosed within the prior art of record.

Conclusion

8. A list of relevant prior art appears below not relied upon in this Office Action:

US Patents:

Towers (US 4,334,270) discloses a security valuation system

Williams et al (US 5,999,918) discloses an interactive color confidence indicators for statistical data.

Ray et al (US 6,018,722) discloses a SEC registered individual account investment advisor expert system.

Jones et al (US 6,021,397) discloses a financial advisory system

Lucas et al (US 4,751,640) discloses an automated investment system

Kalmus et al (US 4,674, 044) discloses an automated securities trading system.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Daniel S. Felten** whose telephone number is (703) 305-0724. The examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday. Any inquiry of a general nature relating to the status of this application or its proceedings should be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor **Vincent Millin** whose telephone number is (703) 308-1065.

10. Response to this action should be mailed to:

Commissioner of Patents and Trademarks

1 Washington, D.C. 20231

2
3 for formal communications intended for entry, or (703) 305-0040, for informal or draft
4 communications, please label "Proposed" or "Draft".

5 Communications via Internet e-mail regarding this application, other than those under 35
6 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be
7 addressed to [daniel.felten@uspto.gov].
8

9 All Internet e-mail communications will be made of record in the application file. PTO
10 employees do not engage in Internet communications where there exists a possibility that
11 sensitive information could be identified or exchanged unless the record includes a properly
12 signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly
13 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
14 Trademark on February 25, 1997 at 1 195 OG 89.
15

16
17 

18 DSF

19 May 23, 2002



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